

Information Disclosure Statement

[1] The information disclosure statement (IDS) submitted on 10/18/10 was filed after the mailing date of the first Office action on the merits on 7/22/10. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

[2] Although Document JP 8-510387 is listed at p. 2 of the IDS filed on 10/18/10, there is no copy of this document. Rather, a copy of JP 8-510837 has been filed on 10/18/10. As such, the foreign patent document number, name of patentee, and date of publication have been changed at p. 2 of the IDS to correspond to JP 8-510837.

Restriction/Election

[3] Upon further consideration, the requirement for restriction between Groups I(a) and I(b) as set forth in the Office action mailed on 1/30/04 is withdrawn and in accordance with the Office communication mailed on 8/26/05, the requirement for restriction among Group I(a), Group X(a), and Group X(b) is withdrawn.

[4] In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32

(CCPA 1971). See also MPEP § 804.01.

Reasons for Allowance

[5] The following is an examiner's statement of reasons for allowance. At the time of the invention, *P. pyralis* luciferase of SEQ ID NO:37 and variants thereof were well-known in the prior art. See, e.g., Squirrell et al. (WO 96/22376; cited in the IDS filed on 12/30/08). However, the prior art neither teaches nor suggests replacing Thr214 and Ile232 of *P. pyralis* luciferase with alanine. It is noted that Wood et al. (US Patent 6,387,675; cited in the IDS filed on 10/18/10) expressly teaches a mutation at a position corresponding to residue 232 of the mutant beetle luciferase of SEQ ID NO:2. However, residue 232 of SEQ ID NO:2 of Wood et al. does not correspond to position 232 of *P. pyralis* luciferase of SEQ ID NO:37 herein. Rather, residue 232 of the mutant beetle luciferase of SEQ ID NO:2 of Wood et al. corresponds to residue 235 of SEQ ID NO:37.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Fri, 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao can be reached on 571-272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David J. Steadman/
Primary Examiner, Art Unit 1656